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OFFICE OF PETITIONS

In re Application of
Yuri V. Melnik et al
Application No. 09/903,047
Filed: July 11, 2001
Atty Dkt No. 2023600-7006242001

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:DECISION GRANTING PETITION
:UNDER 37 CFR 1.137(b)
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This is a decision on the petition, filed July 23, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f). This is also a decision on the petition filed July 23, 2003, and supplemented on July 28, 2003, to withdraw the instant application from issue. The decision mailed July 24, 2003 is hereby vacated.

The petition under 37 CFR 1.137(f) is GRANTED.

The petition under 37 CFR 1.313(b)(1) is DISMISSED as moot.

Turning first to the petition to withdraw from issue, petitioner requests that the instant application be withdrawn from issue "for its express abandonment." The petition further states that the petition to withdraw from issue is being filed while pending a decision on a simultaneously filed petition under 37 CFR 1.137(f). In a supplement to the petition received on July 28, 2003, petitioner clarifies the petition to withdraw from issue by indicating that the application is not to be expressly abandoned in that it has been applicants' intent to allow the application to issue and that the petition to withdraw from issue was believed necessary in order to allow consideration of the petition to revive.

It is unnecessary, in this particular instance, to withdraw the application from issue to consider a petition to revive under 37 CFR 1.137(b). Further, a petition to withdraw from issue for the purpose of consideration of a petition to revive does not meet

any of the conditions set forth in 37 CFR 1.313 for withdrawing an application from issue. Therefore, for the reasons indicated above, a petition to withdraw this application from issue is not the appropriate avenue of relief herein and is dismissed as involving a moot issue.

Turning next to the petition under 37 CFR 1.137(b), petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on July 8, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the USPTO of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

- (1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of November 6, 2003 accompanies this decision on petition.

A Notice of Allowability and a Notice of Allowance and Fee(s) Due were mailed in this case on March 24, 2003. However, in view of the nonpublication request filed with the application, the Notice of Allowance and Fee(s) Due mailed in this case did not require the submission of a publication fee. Therefore, in view of the rescinding of the nonpublication request, a Notice of Publication Fee Due is being mailed under separate cover. Petitioner should note that payment of the publication fee is required to be filed within the period set forth in the Notice to avoid abandonment of the application.

This application is being forwarded to Publishing Division to await a reply the Notice of Publication Fee Due mailed July 30, 2003.

Any inquiries concerning this decision may be directed to Wan Laymon at (703) 306-5685.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request